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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,677	02/27/2004	Michael D. Smith	418268004US	3591
45979 7590 04/29/2011 PERKINS COIE LLP/MSFT P. O. BOX 1247 SEATTLE, WA 98111-1247				
EXAMINER EVANS, KIMBERLY L				
ART UNIT 3629		PAPER NUMBER		
NOTIFICATION DATE 04/29/2011		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentprocurement@perkinscoie.com

Office Action Summary

Application No.

10/788,677

Applicant(s)

SMITH ET AL.

Examiner

KIMBERLY EVANS

Art Unit

3629

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 1, 2, 5, 7-11, 22, 23, and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 1, 2, 5, 7-11, 22, 23, and 25-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment after final filed on March 22, 2011.
2. Claims 7 and 8 have been amended and are entered.
3. Claims 1, 2, 5, 7-11, 22, 23, and 25-29 are currently pending and have been examined.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 - i. Determining the scope and contents of the prior art.
 - ii. Ascertaining the differences between the prior art and the claims at issue.
 - iii. Resolving the level of ordinary skill in the pertinent art.
 - iv. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1, 2, 5, 7-11, 22, 23, and 25-29 are rejected under 35 USC 103(a) as being unpatentable over Medvinsky et al., US Patent Application Publication No US 2003/0093694 A1, in view of Zhang et al., US Patent Application Publication No US 2005/0076220 A1.
7. With respect to Claims 1, 11, 22, and 25, Medvinsky discloses the following limitations,
- *acquiring by the processor, a block of tickets at a time from a ticketing entity, the block of tickets including at least one ticket having a value specified by a sender of a message*
 - *receiving an electronic message having a ticket issued by a ticketing entity, the ticket having a value that is specified by a sender*

(see at least Figure 1, paragraph 16: "...Note that the user may have previously obtained a caching server ticket from the KDC. A ticket is an authentication token and it may include the client, a server name, a session key, etc. The ticket further contains authorization data indicating subscribed services, user payment method, etc. This ticket and the session rights object are thereafter presented to the caching server which compares user selection and/or content access rules in the session rights object with authorization data from the ticket..."; paragraph 28: "...IPRM system 200 comprises a content provider 202, consumer 216, Internet 214, a provisioning center 206, a central server 205 that contains both a database 208 and a search engine 210, caching servers 212, 213 and 215 all of which function in a similar manner to those of the corresponding components in FIG. 1. In addition, IPRM system 200 comprises a KDC (key distribution center) 204 containing an AS (authentication server) 207 for issuing a TGT (ticket granting ticket) to consumer 216, a TGS (ticket granting server) 209 for providing server tickets to access particular servers, a provisioning server 220, and a billing center 211..."; paragraph 36: "...In order to authenticate a message with a ticket (e.g. ESBroker Key Request message), a client would include in this message both a ticket and a checksum value for the session key in the ticket...")

- *each ticket of the block including a code from a sequence of codes generated from a start code using a one-way function;* (see at least paragraph 95: "...Each packet may be encoded..."; paragraph 97: "...These parameters are: EK--RTP encryption key; an Initialization Vector (IV), which is derived from the RTP packet header using a one-way function. It should be observed that because each RTP packet header contains a different sequence number or timestamp, it results in a unique IV per packet....")
- *adding the acquired ticket to the message and forwarding the message with the added ticket to a recipient,* (see at least paragraph 36: "...In order to authenticate a message with a ticket (e.g. ESBroker Key Request message), a client would include in this message both a ticket and a checksum value for the session key in the ticket....")

Medvinsky discloses all of the above limitations, Medvinsky does not distinctly disclose the following limitations, but Zhang however, as shown discloses,

- *presenting the electronic message to a recipient*
- *wherein the message is an electronic mail message* (see at least Abstract: "...For every email sent from a sender to a recipient using the system built upon the present invention...")
- *when the recipient indicates to redeem the ticket, submitting by the processor the ticket to the ticketing entity for redemption,* (see at least Abstract: "...the sender's allotment of anti-spam points would be deducted by a fixed or varied number, depending on the specific implementation of the particular embodiment of the present invention..."; paragraph 20: "...The system comprises the Email Chief for issuing and verifying the fingerprint keys, and issuing and deducting the points...")
- *wherein upon receiving the message, the recipient can conditionally, redeem the value of the ticket from the ticketing entity*
- *when the recipient does not indicate to redeem the ticket, suppressing the redeeming of the ticket so that the recipient can conditionally redeem tickets*
(see at least paragraph 21: "...the Email Chief asking the recipient's server to hold the email, and 4) the Email Chief sending a message to the sender requesting the sender to register.

paragraph 37: "...A ticket may have other information as well, including a validity period (start time and expiration time), various flags, client authorization data, etc....")

- *and wherein a mail server is provided with an end code of the sequence of codes and determines whether a ticket of the message includes a code from which the end code can be derived.*
- *wherein the ticketing entity receives an end code of a sequence of codes and determines whether the ticket includes a code from which the end code can be derived and charges the sender for a value of the ticket* (see at least Figure 1, paragraph 58: "...before making the email available for the recipient (R), the incoming server (MI) contacts the Email Chief (C) in step 3, by sending an encoded string which contains the sender's profile including, but not limited to the sender's email address, the recipient's email address, MI's identification code, the sender's fingerprint key (if provided); if the Email Chief (C) can match the fingerprint key with the one in the record for the given email address, it will, in step 4, deduct the appropriate anti-spam points of the sender (S) and send an acknowledgment to the incoming email server (MI) or the recipient's email client software to instruct it to make the email available for downloading...")
- *wherein a sender's account and a recipient's account are maintained by the same entity* (see at least paragraph 78: "...The system comprises the Email Chief for issuing and verifying the fingerprint keys, and issuing and deducting the points...")
- *wherein a sender's account and a recipient's account are maintained by different entities* (see Figure 1, paragraph 108: "...The system includes a sender's computer S, a recipient's computer R, the sender's SMTP email server MO, the recipient's email server MI, and the Email Chief C for registration/authentication purposes. The present invention can be deployed at the recipient's email server MI or at the recipient's email client software R, and at the Email Chief C. The Email Chief C has the function for registration, authentication, and maintenance of database...")

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Medvinsky to include the system of Zhang because it would provide an efficient means for differentiating spammers from non-spammers via registering and verifying the sender's fingerprint key and deducting sender's anti-spam points. This would provide an efficient means for authenticating senders and once verified, delivering the email to the recipient.

8. With respect to Claim 2,

Medvinsky and Zhang disclose all of the above limitations, Medvinsky further discloses,

- *the acquired ticket includes a sender authenticating code so that a mail server that receives the message can authenticate the sender of the message.* (see at least paragraph 6: "...Kerberos is a key management protocol, allowing a party to establish shared session keys with different network services by using a KDC (key distribution center) and the concept of tickets. A ticket is used to securely pass to a server a session key along with the identity of the client for whom the ticket was issued. A ticket is tamperproof and can be safely stored by the clients, allowing servers to remain stateless (a server can re-learn the session key each time that the client passes it the ticket)..."; paragraph 47: "...The KEY_REQ message contains a MAC (message authentication code) of the message, DOI (domain of interpretation) object and a time stamp in addition to the caching server ticket..."; paragraph 64: "...At block 514, a public/private key pair for authenticating AS_REQ messages between consumer 216 and KDC 204 is generated...")

9. With respect to Claim 5,

Medvinsky and Zhang disclose all of the above limitations, Medvinsky further discloses,

- *wherein the tickets are added to messages in reverse order of generation of their codes.*(see at least paragraph 197: "...Note that the derivation order of the inbound and outbound keys at the client and server are reversed....")

10. With respect to Claims 7, 27 and 29,

Medvinsky and Zhang disclose all of the above limitations, Zhang further discloses,

- *the recipient's mail system can validate the ticket with the ticketing entity before presenting the message to the recipient*
- *validating that the ticket can be redeemed before presenting the ticket to the recipient*
(see at least paragraph 67: "...function of holding the email and communicating with the Email Chief can be done by the recipient's email client....")

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Medvinsky to include the system of Zhang because it provides an efficient means for delivering legitimate emails without spamming recipients.

11. With respect to Claim 8,

Medvinsky and Zhang disclose all of the above limitations, Zhang further discloses,

- *the recipient's mail system can automatically discard messages with ticket values below a threshold value set by the recipient.*(see at paragraph 41: "...If the recipient's threshold value is lower than the advertiser's threshold value, then the email will be delivered, and if not, the email will not be delivered. ...")

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Medvinsky to include the system of Zhang because it provides an efficient means for a recipient to set a threshold value for unsolicited emails according to his or her opportunity costs.

12. With respect to Claims 9, 23 and 28,

Medvinsky and Zhang disclose all of the above limitations, Zhang further discloses,

- *when the recipient redeems the ticket, an account of the sender is debited.*
- *wherein the redemption includes decreasing an account balance of the sender and increasing an account balance of the recipient*

(see at least Abstract: "...every email sent from a sender to a recipient using the system built upon the present invention, the sender's allotment of anti-spam points would be deducted by a fixed or varied number, depending on the specific implementation of the particular embodiment of the present invention ..."; paragraph 20: "...The system comprises the Email Chief for issuing and verifying the fingerprint keys, and issuing and deducting the points)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Medvinsky to include the system of Zhang because the Email Chief provides an efficient means for issuing and tracking points for registered email senders.

13. With respect to Claims 10 and 26,

Medvinsky and Zhang disclose all of the above limitations, Zhang further discloses,

- *when the recipient redeems the ticket, an account of the sender is credited.*
- *wherein the entity that maintains the sender's account transfers the value to the entity that maintains the recipient's account.*

(see at least paragraph 20: "...The system makes available an online registration form, and when the sender completes the form, the system would issue a certain number of free (no charge) anti-spam points, hereinafter referred to as Pass Points..."; paragraph 54: "...the Email Chief C can send registration requests to email senders that are not in the current pool of registered users, can communicate with email senders, can issue a fingerprint key for each email address after a successful registration, can issue a certain amount of free Pass Points for the email address, and can replenish or infuse it with more Pass Points after a fixed or varied period of time. These free Pass Points will be deducted by a fixed or varied number each time the user sends out an email to the email servers adopting the present invention. These free Pass Points will be automatically replenished for the user after a fixed or varied period of time has elapsed..."; paragraph 63: "...if the Email Chief C can match the fingerprint key with the one in the record for the given email address, and verifies that the limit on the number of Ad points offered to the recipients meets or exceeds the threshold value for

charging paid Ad Points set by the recipient R, then B deduct from sender S' account the number of Ad points that matches R's threshold value, and credits them to R's account...")

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Medvinsky to include the system of Zhang because the Email Chief provides an efficient means for issuing and tracking points for registered email senders.

Response to Remarks

14. Applicant's arguments received March 22, 2011 have been fully considered and are found to be persuasive, Examiner respectfully agrees with applicant's representative that the Burrows reference is not applicable under 35 U.S.C. § 102(e) nor does the Burrows reference in the Final Office Action qualify under 102(a).

Conclusion

15. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Kimberly L. Evans** whose telephone number is **571.270.3929**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Jami Plucinski** can be reached at **571.272.6811**.
16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center

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(EBC) at **866.217.9197** (toll-free). Any response to this action should be mailed to: **Commissioner of Patents and Trademarks**, P.O. Box 1450, Alexandria, VA 22313-1450 or faxed to **571-273-8300**. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**: Randolph Building 401 Dulany Street, Alexandria, VA 22314.

/KIMBERLY EVANS/Examiner, Art Unit 3629

/Jamisue A. Plucinski/

Supervisory Patent Examiner, Art Unit 3629